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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,994	05/04/2006	Peter James Hayward	CH8365	9452
7590 Lanxess Corporation Law & Intellectual Property Department 111 Ride Park West Drive Pittsburgh, PA 15275-1112			EXAMINER ANTHONY, JOSEPH DAVID	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 06/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,994

**Applicant(s)**

HAYWARD ET AL.

**Examiner**

Joseph D. Anthony

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/22/06 as a preliminary amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/06)  
Paper No(s)/Mail Date 10/16/06 and 07/03/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure, filed with the preliminary amendment of 08/22/2006, does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is confusing since it uses improper Markush claim language. Proper Markush claim language is: --selected from the group consisting of--.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heuer et al. U.S. Patent Number 5,874,025.

Heuer et al. teach novel wood preservatives comprising at least one copper compound and polyaspartic acid or a derivative of the same, a triazole compound and if appropriate at least one synergistically complementing other fungicide and/or insecticide if appropriate an emulsifier and/or a small amount of alkanolamine. Some preferred fungicidal triazole compounds are **triadamefon** and **triadimenol**, see column 7, line 63 to column 8, line 21. Especially note column 8, line 19. Water and optional organic solvents are disclosed to be used in the wood preservative compositions, see column 17, lines 18-54. The further inclusion of **organic binders**, which reads on applicant's glue component, are disclosed in column 17, line 55 to column 18, line 14. Wood which can be protected with the wood preservative composition can be selected from **plywood and chipboard**, see column 18, lines 34-45. Heuer et al. discloses that the wood preservative composition can be applied to the wood or wood based materials, such as chipboard and plywood, using various methods. *One such specifically disclosed method is where the wood preservative composition is incorporated by the glue incorporation method of making wood based products*, such as chipboards or plywood, see column 19, lines 28-36. Please note that said glue incorporation method is deemed to be generic to applicant's claimed "glue-line addition" method of dependent claim 4.

Heuer et al. differ from applicant's claimed invention in that there is not a direct teaching (i.e. by way of an example) to where a wood preservative composition

comprising **triadamefon** and/or **triadimenol** is actually applied to or incorporated into wood based products, such as plywood or chipboards, that are made using a binder, such as a glue.

It would have been obvious to one having ordinary skill in the art to use at least the above cited sections of Heuer et al., as strong motivation to incorporate a wood preservative composition comprising **triadamefon** and/or **triadimenol** into the **glue binder** used to make **plywood** and/or **chipboard** type wood based products. The further addition of additional fungicides/insecticides are directly disclosed by the patent.

#### ***Prior-Art Cited But Not Applied***

Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

#### ***Examiner Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

**/Joseph D. Anthony/  
Primary Patent Examiner**

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**06/22/09**